

REMARKS

1. Amendment of the Specification:

On pages 2, 3 and 5 of the Specification have been amended to clarify the complex waveform recited in the Specification is an audio spectrograph tracing. Support for this amended language is found in the Abstract. No new matter is being submitted.

1. Amendment of Claims:

The Examiner rejected Claims 1 and 2 under U.S.C. 102(b) as being anticipated by Harris (5,923,556). According to the Examiner, Harris discloses in Fig. 1A and 1B a graphic and sound coordinated novelty item as well as a method of promotion as recited in Claims 1 and 2.

In response, that Harris discloses a novelty item that include the image of the heart and an image that represents an electrocardiogram tracing. An electrocardiogram tracing does not represent the sound of heart. (See Addendum A). Therefore, the 102(b) rejection should be withdrawn.

In response to the Applicant's arguments submitted in the Amendment filed on August 22, 2003, the Examiner rejected the arguments on the grounds that the clause "produced by an audio spectrograph" does not structurally limit the claim. While the Applicant respectfully disagrees that the specific clause makes the claim a 'product by process' claim, the Applicant hereby amends Claims 1 and 2 by replacing the term "complex waveform" with "an audio spectrograph tracing" in order to overcome this rejection

The Examiner newly rejected Claim 2 under 35 U.S.C. 103(a) based on Harris in view of Applicant's own admittance. According to the Examiner, the Applicant's statement on page 2, lines 14-17 that an audio spectrograph used to produce a complex waveforms is an

1 admission that supports a finding of obvious. The Applicant respectfully submits that such
2 reasoning is not sufficient to support a finding of obviousness and should be withdrawn.

3 The mere fact that references can be combined or modified does not render the
4 resultant combination obvious unless the prior art also suggests the desirability of the
5 combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness
6 cannot be established by combining the teachings of the prior art to produce the claimed
7 invention, absent some teaching, suggestion or incentive supporting the combination. *ACS*
8 *Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933
9 (Fed. Cir. 1984).

10 To establish obviousness based on a combination of the elements disclosed in the
11 prior art, there must be some motivation, suggestion, or teaching of the desirability of making
12 the specific combination that was made by the applicant. In this instance, the Examiner has
13 merely stated that because the Applicant admits that all sounds can be represented by an
14 audio spectrographic tracing, it would be obvious to replace Harris' electrocardiogram with
15 an audio spectrographic tracing of the heart. The Applicant submits that there is no
16 motivation, suggestion or teaching in Harris that supports the Examiner's statement.

17 As stated on page 2, lines 17-21, the main objective of the invention is to create a
18 marketing tool that uses an image that depicts an object or an activity and the image of a
19 complex waveform by an acoustic spectrograph of a sound associated with the first image. It
20 is the Applicant's belief that most people find the presentation of a sound in a complex
21 waveform by an acoustic spectrograph fascinating that coupling the complex waveform
22 with the object or activity depicted in the first image reinforces the first image in the viewer.

23 The Applicant submits that no prior art reference exists for a novelty or promotional

1 item that uses an audio spectrograph tracing of a sound associated with an object or activity
2 depicted or presented on the item that reinforces the object or activity with the viewer. Harris
3 provides no motivation for replacing the electrocardiogram with an audio spectrograph
4 tracing except for the reasons offered by the Applicant. An electrocardiogram is a graphic
5 display or tracing showing the electrical conduction activity of the heart. An
6 electrocardiogram does not represent the sound of the heart. In order for a viewer to
7 understand the ‘novelty’ aspect of the greeting card, the viewer must only understand the
8 specific relationship between an electrocardiogram and the heart. The viewer does not
9 analyze the electrocardiogram to determine a sound associated with the heart.

10 As discussed in the previous Office Action Amendment, the images of an object or
11 activity and an audio spectrograph tracing associated with the object or activity requires the
12 viewer to closely review the tracing and contemplate the various sounds associated with the
13 object or the activity. Normally, when an audio spectrographic tracing is initially seen by a
14 viewer, the viewer tries to vocalizes a sound associated with the object or activity. The
15 applicant submits that the viewer’s contemplation and vocalization of the sound reinforces
16 the first image, thus making the item an outstanding novelty or promotional item. Because
17 electrocardiograms are well know and do not represent sounds, the viewer does not
18 contemplate nor vocalize the electrocardiogram to understand the image of the heart.

19 In summary, “obvious to try” basis suggested by the Examiner is an improper basis
20 for a §103 rejection when there is no suggestion in Harris to associate the image of the heart
21 with the image depicting a sound associated with the heart.

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1 Respectfully submitted,

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